

REMARKS

Claims 48-51 were pending in the present application. Claims 1-47 and 52 were canceled. By virtue of this response, claims 48 and 50-51 have been amended. New claim 53 has been added. Amendments and new claims are supported by the specification and claims as originally filed, e.g., at p. 12, ll. 4-23; p. 25, ll. 20-23; p. 26, l. 1 to p. 27, l. 3. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. No new matter has been added.

Rejections under 35 U.S.C. §103 – I

Claims 48-51 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Gershman (US 6,356,905) or Treyzin (US 6,587,835) and further in view of Trotta, Jr. (US 5,595,264)

In response, Applicants respectfully disagree.

It is well established that a *prima facie* case of obviousness requires that all the elements of the claim must be considered and given weight. Applicants submit that the combination proposed by the Office Action fails to recite all of the requirements of independent claims 48 and 50-51 as amended.

Claim 48 recites "...executing a transaction in response to a received transaction execution request, including communicating with the at least one server using data received from the mobile device, and further comprising automatic payment using the wireless bar code reader device information, automatically entering an item in an inventory database as sold, enabling the item to be removed from a store, wherein the transaction execution request can be transmitted from a remote position and local position relative to the store." Similar elements have been added to claims 50-51.

The Office Action acknowledges that neither Gershman or Treyz teaches the step of "executing a transaction in response to a received transaction request..." according to the pending claims, but states that Trotta, Jr. supplies this missing element, and that it would have been obvious to a person having ordinary skill in the art to include in Gershman or Treyz the execution step of Trotta, Jr. "because this will eliminate the lengthy and sometimes

objectionable checkout queues in which the customer must wait, thus saving time for the customer.” OA p. 3-4.

Applicants submit that Trotta Jr., however, is directed to a system and method of automated shopping where “the customer enters the store 30 and inserts a credit card...into a receiving mechanism or slot 12 in the scanner terminal 18, where a plurality of scanners 14 are secured within holders 16.” Col. 3, ll. 41-52. “After receiving the portable scanner 14, the customer enters the display aisles in the store to select the desired items for purchase...the scanner 14 transmits the purchase information to a central, in-store computer 20.” Col. 5, ll. 1-34.

The automated shopping system of Trotta Jr. is limited in that it utilizes scanners for selecting items within a store, where selection of desired items for purchase and the transmission of purchase information to execute a sale can only take place locally at the store from which the items are being purchased via communication between the in-store scanner and the local “in-store computer 20.” Trotta Jr. does not teach or suggest “executing a transaction in response to a received transaction execution request... wherein the transaction execution request can be transmitted from a remote position and local position relative to the store.” Furthermore, a person of skill in the art would have no reason to modify the system of Trotta Jr. to allow for transaction execution requests to be transmitted from a remote position relative to the store where the system of Trotta Jr. is specifically designed to utilize communication between an in-store scanner and in-store computer such that the point of sale and point of selection occur simultaneously within the store to avoid lengthy check-out lines in the store.

Thus, because all of the elements of the claimed invention have not been taught or suggested by the cited art, Applicants submit that a prime facie case of obviousness has not been established.

In view of the above, Applicants submit that the rejection fails to establish a proper *prima facie* case of obviousness. Gershman and Treyz fail to teach or suggest the requirements of claims 48 and 50-51 as amended. The addition of Trotta Jr. does not address the deficiencies in Gershman or Treyz. Accordingly, Applicants believe claims 48 and 50-51 as well as any claim ultimately dependent therefrom are patentable over Gershman or

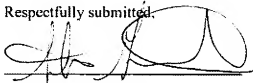
Treyzin and further in view of Trotta, Jr. Applicants respectfully request that the above rejections be withdrawn.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections and pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the appropriate fee and/or petition is not filed herewith and the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with this filing to **Deposit Account No. 50-3973** referencing Attorney Docket No. **IPHLNZ00202**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,



Steven M. Giovannetti
Registration No. 51.739

Customer No. 40518
Levine Bagade Han LLP
2400 Geng Road, Suite 120
Palo Alto, CA 94303
Direct: (650) 646-2570
Fax: (650) 284-2180